



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/137,059 08/20/98 JOHNSTON B A-65200/WHD/

HM12/0627

FLEHR HOHBACH TEST
ALBRITTON & HERBERT
SUITE 3400 FOUR EMBARCADERO CENTER
SAN FRANCISCO CA 94111

EXAMINER

SCHMIDT, M

ART UNIT

PAPER NUMBER

1635

19

DATE MAILED:

06/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/137,059

Applicant(s)

Johnston et al.

Examiner

Schmidt

Group Art Unit

1635

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 04/05/00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 23 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 23 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 16 ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Art Unit: 1635

DETAILED ACTION

1. Applicant's election without traverse of Group IV, claim 23, in Paper No. 18/E filed 4/05/00 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 is indefinite for the language "capable of" (line 4) for merely defining a latent characteristic of the "inactive RNA molecule," the metes and bounds of which are not known.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1635

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 23 is rejected under 35 U.S.C. 102(a) as being anticipated by Kramer et al. (U.S. Patent 5,616,459).

Claim 23 is drawn to a method for detecting the presence of a target molecule in a composition by contacting the composition with a catalytically inactive RNA molecule such that upon binding of the catalytically inactive RNA molecule to the target "said target molecule allows said catalytically inactive RNA molecule to become catalytically active."

The claim reads on administration of any trans-ribozyme to its target nucleic acid since trans-ribozymes inherently function as claimed, ie. are catalytically inactive until bound to target, upon which they are catalytically active to cleave the target. Kramer et al. teach ribozymes which are designed to cleave a target (see abstract).

6. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Draper et al. (U.S. Patent 5,496,698).

Claim 23 is drawn to a method for detecting the presence of a target molecule in a composition by contacting the composition with a catalytically inactive RNA molecule such that upon binding of the catalytically inactive RNA molecule to the target "said target molecule allows said catalytically inactive RNA molecule to become catalytically active."

The claim reads on administration of any trans-ribozyme to its target nucleic acid since trans-ribozymes inherently function as claimed, ie. are catalytically inactive until bound to target,

Art Unit: 1635

upon which they are catalytically active to cleave the target. Draper et al. teach ribozymes which are designed to cleave a target (see abstract).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

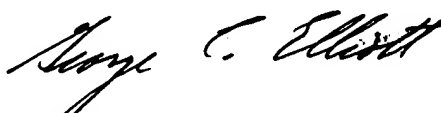
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

M. M. Schmidt
June 12, 2000


George C. Elliott, Ph.D.
Supervisory Patent Examiner
Technology Center 1600